REMARKS

This Response is being submitted along with a Request for Continued Examination (RCE). Below please find a response concerning references cited in the previous Office Action against the present application.

Claims 4 and 5 were amended for clarification purposes. No new matter has been added. Claims 4 to 8 are pending. Applicants respectfully request reconsideration of the present application in view of this response.

Claims 4 to 6 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,101,602 to Fridrich ("Fridrich reference") in view of U.S. Patent No. 6,504,941 to Wong ("Wong reference").

As discussed in Applicants' earlier submission, the Fridrich reference purportedly concerns a digital image that is authenticated by an embedded pattern created by hashing the image and adding a signature element. The Fridrich reference recites that to determine whether the image is authentic, one retrieves the watermark by subtracting the watermarked image from the original to obtain the difference, and the value of the correlation between the difference thus obtained and the smoothed pattern determines the presence or absence of the watermark.

The Wong reference purportedly concerns a watermark insertion procedure which computes a hash function and then combines the output of the hashed function of a modified image block, a key and various image parameters with a block of the watermark bitmap, resulting in a combined image block. The Wong reference refers, as a final step, to create a watermarked image block, the combined image block is inserted into the LSB of the modified image; the watermark extraction procedure taking the watermarked image block and creating two different image blocks: a first image block with the LSB's of the watermarked image block set to zero, and a second image block with the LSB's of the watermarked image block extracted. The Wong reference further refers to the watermark extraction procedure as using the hash function to calculate a digest of values, resulting in a hashed output, the hashed output being combined with the second image block, preferably using an exclusive OR function, and the result of the combined hashed output with the second image block being a block of the extracted watermark.

In contrast, claim 4 of the present application is directed to a method for generating a digital watermark for an electronic document, including generating the watermark as a function of a proof of identity identification and the first hash value of the document, *providing a secret key for making the watermark visible*, embedding the watermark in the document, restoring the document to an original state by removing the watermark using the secret key, determining a hash value of the restored document, *and verifying ownership of the document by comparing the hash value of the restored document and the first hash value.*

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That is, among other features, claim 4 provides for a determination of the originator of the document. Neither the Fridrich nor the Wong references (alone or in combination) teach or suggest such a feature. For example, the Office Action directs us to col. 6, line 65 to col. 7, line 5, of the Fridrich reference, which appears to merely recite that the watermark will also "contain an important piece of information uniquely connected to the author of the image" – but does not specify that it is the comparison of the hash value of the restored document and the first hash value. In addition, the Fridrich reference – as discussed in the Office Action – does not use a secret key. The Wong reference does not cure this deficiency in a manner required. That is, the Wong reference does not include any express motivation for combining use of a secret key in the method of the Fridrich reference.

The law requires that to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990). *Applicants respectfully submit that the afterthought required to combine the references involves hindsight, rather than an explicit suggestion in the references to combine such techniques in the manner claimed above. The very fact that the combination would make a better result is the reason for a new application and not a rejection for an invention not yet contemplated.* Accordingly, it is respectfully submitted that claims 4 to 6 are allowable over the Fridrich and Wong references.

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) over the Fridrich and Wong references further in view of U.S. Patent No. 6,636,615 to Rhoads. Claims 7 and 8 depend from claim 4 and, as discussed above, are believed allowable over the Fridrich and Wong references (alone or in combination) for at least the same reasons. The Rhoads reference purportedly concerns two or more digital watermarks, with different characteristics, embedded in a document, for which characteristics are chosen so that the watermarks will be affected in different manners if the document is subsequently copied or reproduced, involving a detection process or mechanism which reads two or more of the watermarks and compares their characteristics. The Rhoads reference does not cure the deficiencies of the Fridrich and Wong references – discussed above – even when taken in combination. Accordingly, Applicants respectfully submit that claims 7 and 8 are allowable over the cited art.

It is therefore respectfully submitted that claims 4 to 8 are allowable.
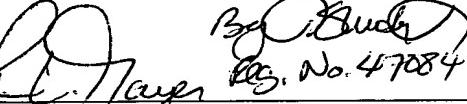
CONCLUSION

In view of the foregoing, it is believed that claims 4 to 8 are allowable. It is therefore respectfully requested that the present application issue.
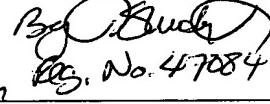
Respectfully submitted,

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